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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

PENN ENGINEERING &
MANUFACTURING CORP., and
PEM MANAGEMENT, INC.,

Plaintiffs,

v.

PENINSULA COMPONENTS, INC.,

Defendant.

Case No. C07 04231 CRB

**PLAINTIFFS' CASE MANAGEMENT
CONFERENCE STATEMENT**

JURY TRIAL DEMANDED

Pursuant to Civil L.R. 16-9(a), plaintiffs Penn Engineering & Manufacturing Corp. and PEM Management, Inc., (collectively, "PEM") attempted to meet and confer with defendant Peninsula Components, Inc., ("Pencom") regarding the filing of a Joint Case Management Statement. Despite reasonable efforts by PEM, the defendant failed to agree to a timely meet and confer as required by Federal Rule of Civil Procedure 26(f), and PEM was unable to obtain the cooperation of Pencom in preparing a joint statement.¹ PEM's efforts to obtain Pencom's cooperation are set forth in the accompanying Declaration of Rebecca A. Beynon. Accordingly, PEM submits a separate Case Management Conference Statement and requests the Court to adopt it as its Case Management Order in this case.

1. Jurisdiction and Service:

PEM alleges that Pencom infringes PEM's patents and trademark. Therefore, the Court has jurisdiction over all claims for relief pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338(a). Because Pencom's principal place of business is located in this district, the Court has personal jurisdiction over the Pencom. Venue is proper in the Northern District of California under 28 U.S.C. §§ 1391(c) and 1400. PEM properly served Pencom with the Complaint in this action on August 21, 2007.

2. Facts:

PEM is a designer and manufacturer of "self-clinching fasteners," and owns intellectual property relating to self-clinching fasteners. Pencom is a competing seller of self-clinching fasteners.

PEM filed this action on August 15, 2007, seeking a ruling that Pencom has infringed U.S. Patent Nos. 5,239,135; D437,209; D357,176; D388,316; and D400,430 (collectively, the "Patents-in-Suit,") and U.S. Registered Trademark No. 1,400,893 (the "'893 Trademark"). PEM

¹ On November 14, 2007, the due date for this filing, Pencom sent an e-mail to counsel for PEM stating that it "realistically ... may not be able to handle this until tomorrow." PEM files this statement to ensure that it complies with the deadlines set in the Local Rules and the Court's standing orders. However, PEM will continue to work with counsel to Pencom in an effort to prepare a joint statement to replace this separate Case Management Conference Statement. *See* Declaration of Rebecca A. Beynon ¶ 9 (Nov. 14, 2007).

1 further seeks a ruling that Pencom has engaged in counterfeiting of its trademark and otherwise
2 violated PEM's rights under the Lanham Act, 15 U.S.C. § 1125.

3 **3. Legal Issues:**

4 PEM asserts that the legal issues for determination include the proper construction of the
5 claims of the Patents-in-Suit; whether Pencom has infringed the Patents-in-Suit; and whether
6 Pencom has infringed the '893 Trademark.

7 **4. Motions:**

8 No motions have been filed in this case.

9 **5. Amendment of Pleadings:**

10 PEM does not currently plan on amending the pleadings. However, PEM reserves the
11 right to amend the pleadings upon obtaining discovery in this case.

12 **6. Evidence Preservation:**

13 PEM has undertaken efforts to preserve relevant evidence in this case.

14 **7. Disclosures:**

15 PEM has served its initial disclosures on November 14, 2007. At the time of this filing,
16 Pencom had not served its initial disclosures.

17 **8. Discovery:**

18 To date, the parties have not conducted any discovery in the instant action. PEM
19 anticipates that discovery will be needed on the issues raised by the pleadings, specifically
20 including the following topics:

- 21 • The proper construction of the claims of the Patents-in-Suit;
- 22 • Whether Pencom has infringed the Patents-in-Suit;
- 23 • Whether Pencom has infringed the '893 Trademark;
- 24 • Whether Pencom has counterfeited the '893 Trademark; and
- 25 • Whether Pencom has infringed PEM's trade dress.

26 PEM asserts that discovery should not be conducted in phases or focused upon particular
27 issues.

1 PEM asserts that each side of this case should be limited to taking 100 hours of
2 deposition testimony. PEM asserts that each party should be allowed to issue 25 interrogatories
3 in total, as provided in Fed. R. Civ. Proc. 33(a).

4 While PEM anticipates that the discovery limits set forth above will be adequate to
5 permit the parties to prepare their respective cases, PEM expressly reserves the right to seek
6 modification by the Court for good cause shown, of the proposal set forth herein.

7 PEM's proposed discovery plan is attached hereto as Exhibit A.

8 **9. Class Actions:**

9 This is not a class action.

10 **10. Related Cases:**

11 PEM brought suit against six unrelated defendants in the U.S. District Court for the
12 District of Nevada on November 13, 2007. *See Penn Engineering & Manufacturing Corp. v.*
13 *Shanghai Jingyang Import & Export Co., Ltd.*, 2:07-cv-01505 (D. Nev.). That suit claims
14 infringement of PEM's trademarks and patents, including the '893 Trademark and the '209,
15 '176, and '430 patents, among others.

16 **11. Relief:**

17 PEM seeks a reasonable royalty on Pencom's unlicensed sales of products that infringe
18 the Patents-in-Suit during the past six years. In the event that additional evidence uncovered
19 during the discovery period shows that PEM suffered other harm, such as lost sales and/or
20 profits, PEM reserves the right to seek the actual and exemplary damages, including Pencom's
21 total profit on infringing designs, to which the evidence shows PEM to be entitled.

22 PEM also seeks damages, at least in the amount of Pencom's profits, and damages
23 sustained by PEM and the costs of this action, resulting from Pencom's unlicensed sales of
24 products that infringe PEM's trademark. PEM reserves the right to seek statutory or exemplary
25 damages to which the evidence shows them to be entitled. PEM also seeks injunctive relief to
26 stop further patent and trademark infringement by Pencom and destruction of all remaining
27 inventory that infringes PEM's intellectual property.

1 **12. Settlement and ADR:**

2 The parties have stipulated to private mediation after document discovery in this matter,
3 and the Court issued an order approving that stipulation on November 5, 2007.

4 **13. Consent to Magistrate Judge for All Purposes:**

5 PEM has not agreed to consent to a magistrate judge for all purposes.

6 **14. Other References:**

7 PEM has not agreed that this case is not suitable for reference to binding arbitration or a
8 special master.

9 **15. Narrowing of Issues:**

10 The parties have not identified any issues that can be narrowed by agreement or motion at
11 this time.

12 **16. Expedited Schedule:**

13 PEM asserts that this case is not appropriate for expedited scheduling.

14 **17. Scheduling:**

15 PEM's proposed discovery plan, which includes dates for designation of experts,
16 discovery cutoff, hearing of dispositive motions, pretrial conference, and trial is attached hereto
17 as Exhibit A.

18 **18. Trial:**

19 PEM has demanded a jury for the trial of this action.

20 **19. Disclosure of Non-party Interested Entities or Persons:**

21 Pursuant to Civil L.R. 3-16, PEM filed the "Certification of Interested Entities or
22 Persons" contemporaneously with the filing of its Complaint on August 15, 2007. At the time of
23 this filing, Pencom has not filed a certification.

1 20. Such other matters as may facilitate the just, speedy and inexpensive
2 disposition of this matter:

3 (a) Electronically Stored Information

4 PEM asserts that relevant information is likely to be electronically stored, and would
5 agree to endeavor to produce electronically stored information (including emails and electronic
6 documents) and financial records in its native format (including formats such as WordPerfect,
7 Microsoft Word, Excel, PowerPoint, Acrobat PDF, tiff and other off-the-shelf application and
8 those in proprietary formats) to the extent practicable.

9 (b) Protection of Privilege and Work Product

10 PEM asserts that the following provision should be inserted into any Protective Order
11 governing the production of sensitive materials:

12
13 Inadvertent or unintentional production of privileged documents
14 shall not constitute a waiver of the attorney-client privilege or
15 attorney work product doctrine as they apply to those documents
16 specifically or the subject matter of those documents generally. If
17 a party produces documents that it believes should have been
18 withheld as privileged, such party shall provide a written request
19 for the return of those documents within a reasonable time after
20 having actual knowledge that said documents have been produced.
21 The receiving party must then return those documents, along with
any copies thereof, to the producing party within ten (10) calendar
22 days of receiving such notice. The receiving party may challenge
23 the privileged nature of the recalled documents by filing a motion
24 with the Court and requesting in camera review of the documents
25 in question.

26 (c) Other Orders That Could Be Entered By the Court under Rule 26(c) or
27 Rule 16(b) and (c).

28 PEM believes that information relevant to the pleadings herein is of a highly confidential
nature relating to their respective enterprises. Accordingly, the PEM will attempt to seek entry
of a Stipulated Protective Order governing the disclosure of such information.

1 Dated: November 14, 2007

Respectfully submitted,

2 /s/

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14 *Manufacturing Corp. and PEM Management, Inc.*
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EXHIBIT A**Proposed Case Discovery Plan²**

Event	PEM's Proposed Date
Case Management Conference	November 30, 2007
PEM to Serve Disclosure of Asserted Claims and Preliminary Infringement Contentions for Patents-in-Suit	December 12, 2007
Pencom to Serve Preliminary Invalidity Contentions	January 14, 2008
Parties to Exchange Proposed Terms and Claim Elements for Construction	January 24, 2008
Parties to Exchange Preliminary Claim Constructions and Extrinsic Evidence	February 14, 2008
Parties to file Joint Claim Construction and Prehearing Statement (Including Points of Novelty)	March 17, 2008
Parties Complete Claim Construction Discovery	April 4, 2008
Opening Claim Construction Briefs Filed	April 18, 2008
Responsive Claim Construction Briefs Filed	May 2, 2008
Replies in Support of Claim Construction Brief Filed	May 9, 2008
Claim Construction Hearing	Week of May 26, 2008
Fact Discovery Cut-Off	August 22, 2008
Parties to Serve Expert Disclosures	August 29, 2008
Parties to Serve Rebuttal Expert Disclosures	September 12, 2008
Expert Discovery Cutoff	October 3, 2008
Parties to File Dispositive Motions and <i>Daubert</i> Motions	November 7, 2008
Parties to Identify Trial Witnesses and Trial Exhibits	November 21, 2008

² PEM reserves the right to modify these deadlines to accommodate Patent L.R. 3-5 should it become necessary.

Event	PEM's Proposed Date
Parties to file Motions <i>in limine</i>	December 1, 2008
Pretrial Conference	December 8, 2008
Jury Selection	December 9, 2008
Trial	December 16, 2008